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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN MARK SHUSTER and STEVEN CHRISTOPHER BUGG

Appeal 2008-1770
Application 09/893,362
Technology Center 3600

Decided:[1] March 12, 2009

Before HUBERT C. LORIN, LINDA E. HORNER, and ANTON W. FETTING, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

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[1]The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Brian Mark Shuster and Steven Christopher Bugg (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-33, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM.

The Appellants invented a way for delivering customized audio advertisements to users in a manner such that users are not required to perform any action nor are they enabled to control the audio stream provided by these audio advertisements (Specification 1:14-17).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

> 1. A method for providing advertising in a computer network, comprising:
> [1] receiving a request from at least one user
> for delivery of a user-selected Web page associated with a Web site;
> [2] selecting at least one audio advertisement from a plurality of audio advertisements
> for delivery to said at least one user in conjunction with said user-selected Web page; and
> [3] delivering said at least one audio advertisement to said at least one user via said network
> in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement.

This appeal arises from the Examiner's Final Rejection, mailed May 24, 2006. The Appellants filed an Appeal Brief in support of the appeal on March 23, 2007. An Examiner's Answer to the Appeal Brief was mailed on July 17, 2007. A Reply Brief was filed on September 17, 2007. Oral argument was presented at a hearing on February 10, 2009.

PRIOR ART

The Examiner relies upon the following prior art:

Hamzy US 6,636,247 B1 Oct. 21, 2003

Net-mercial.com Partners With GEO Interactive to Deliver Dynamic Audio /Video Internet Advertising Solutions, PR Newswire 2239 (August 18, 1999) (hereinafter "PR Newswire").

REJECTION

Claims 1-33 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hamzy and PR Newswire.

ISSUES

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-33 under 35 U.S.C. § 103(a) as unpatentable over Hamzy and PR Newswire.

The pertinent issue turns on whether it was predictable to one of ordinary skill to preclude bypassing playback of any portion of a web page audio advertisement based on Hamzy and PR Newswire.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of "preclude."

02. The ordinary and customary meaning of "preclude" is to make impossible, as by action taken in advance; prevent; or to exclude or prevent (someone) from a given condition or activity.[2]

Facts Related to Appellants' Disclosure

03. The disclosure states that a Web site "delivers the audio advertisement to the user via the network in a format that precludes the user from controlling the manner of playback of the audio advertisement." (Specification 3:18-20.)

04. The disclosed implementation for this is the loading of the audio file independent of the Web page from where it originated. An audio file will continue to be downloaded onto the user computer system even if the user leaves the Web page before the audio advertisement has begun to play. The method of initiating this download may include the use of hidden frames, i-frames, pop-up windows, passive pop-up windows, or any other ways of creating a connection to the user's Web browser that would be maintained even if the user leaves the Web page that initiated the download connection (Specification 10:20-28).

Hamzy

05. Hamzy is directed to displaying advertisements on the Internet in response to requests for Internet information from a specific website (Hamzy 2:10-12).

06. Hamzy describes attempting to solve a problem prevalent in electronic information distribution systems in which "on line" users often bypass advertisements (Hamzy 1:64-66).

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[2] *American Heritage Dictionary of the English Language* (4th ed. 2000).

07. Hamzy describes a control function to display the advertisement which is correlated to the particular web page for a predetermined time period before transferring the window containing the content or web page the user has selected (Hamzy 2:25-30).

08. Hamzy describes extending display of an advertisement by extending the display time for a predetermined time period before allowing the web page which has been requested to be accessed by the user. The control function which allows the user to proceed is disabled for a predetermined time (Hamzy 7:10-15).

09. Hamzy describes also using a control feature to disable the delete function of the title bar or the "alt F4" function while an advertisement is on display (Hamzy 7:57-60).

PR Newswire

10. PR Newswire is directed to streaming audio and video advertising (PR Newswire:First page).

11. PR Newswire describes how each Net-mercial is displayed inside a window with a black "TV" like frame that draws the user's eye to the content shown on the screen. A timer informs the user that the ad is only temporary and will expire after a certain number of seconds or when the Web site loads (PR Newswire:Second page).

Facts Related To The Level Of Skill In The Art

12. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, user interface design, advertising and promotion, audio advertising systems, and data communications. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See*

Okajima v. Bourdeau, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'") (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

13. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although

an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR*, 127 S. Ct. at 1734. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 1740.

"For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve

similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.*

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742.

ANALYSIS

Claims 1-33 rejected under 35 U.S.C. § 103(a) as unpatentable over Hamzy and PR Newswire.

The Appellants argue these claims as a group. Accordingly, we select claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Hamzy described the limitations of claim 1, except that Hamzy used a visual rather than audio advertisement. The Examiner found that PR Newswire described audio advertisements, also finding that Hamzy listed PR Newswire among its references cited. The Examiner concluded it would have been obvious to combine Hamzy and PR Newswire to apply an audio advertisement to the advertisements described by Hamzy (Answer 3-4).

The Appellants contend that Hamzy fails to describe audio ads and fails to describe precluding bypass of an ad (Appeal Br. 6:Bottom 2 ¶'s and Reply Br. 3:Bottom ¶); that PR Newswire fails to describe or suggest precluding playback and, in fact, teaches not precluding such playback since controls are provided for playback and pause (Appeal Br. 6:Bottom 2 ¶'s, Appeal Br. 7: Bottom ¶ - 8, and Appeal Br. 8:Bottom ¶); and that it is impossible to combine Hamzy and PR Newswire (Reply Br. 4:Bottom ¶).

We disagree with the Appellants. As to the arguments that Hamzy fails to describe audio ads and PR Newswire fails to describe precluding playback, the Appellants are arguing by attacking the references separately, even though the

rejection is based on the combined teachings of the references. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). As to whether Hamzy describes precluding bypass of an ad, we must first construe what is meant by preclude. The Specification provides no lexicographic definition. There are two definitions in general usage – either making impossible or preventing (FF 01 & 02). Since there is always some way to terminate audio playback, if only by terminating power, the limitation of precluding must be construed to mean preventing. There is no limitation in the claim on the mechanism or the strength of such prevention. Hamzy describes both the problem to be solved of users bypassing advertisements (FF 06) and a solution in disabling of user control over an advertisement by extending the display time of an advertisement for a predetermined time period (FF 08), or alternately disabling other window controls (FF 09). Thus Hamzy does describe both the problem of bypassing and the solution by preventing bypassing of advertisements.

While Hamzy describes its invention with visual advertisements, the problem of getting an audience to apprehend an ad applies to auditory advertisements as well. Although Hamzy's examples are visual, Hamzy does not explicitly narrow its scope to visual ads. PR Newswire shows that auditory advertisements were known at the time of the invention (FF 11). While PR Newswire does not describe precluding playback, it was Hamzy that was applied to show this problem and solution.

Finally, as to the argument of impossibility of combining PR Newswire with Hamzy, also argued as teaching away from the invention, the Appellants contend that because one mechanism employed by Hamzy is a control that proceeds from

the advertisement to another web page, such a control would not act to bypass playback. This argument takes Hamzy's control out of context. The purpose of Hamzy's control is to cause the audience to wait for some period of time before proceeding on. Indeed, preclusion is only during playback of the audio advertisement in claim 1, not after the advertisement has been heard. Thus, Hamzy's timer control is directly equivalent to the timing implicit in an audio playback. Thus both Hamzy and claim 1 would cause an advertisement to be before an audience for some predetermined time period as the preventative mechanism.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-33 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-33 under 35 U.S.C. § 103(a) as unpatentable over Hamzy and PR Newswire is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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